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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,554	04/08/2004	David H. Tannenbaum	05708/P005DIV/08008819	8358

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EXAMINER

SALTARELLI, DOMINIC D

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/820,554	Applicant(s) TANNENBAUM, DAVID H.	
	Examiner Dominic D. Saltarelli	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47,48,57 and 72-85 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 47,48,57 and 72-85 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed April 7, 2006 have been fully considered but they are not persuasive.

First, applicant argues that the VPS system disclosed by Kwoh does not establish a stop time for recording (applicant's remarks, page 9 last paragraph).

In response, as described below, the stop time for recording is a merely a value established by the VPS system when a user enters both the start time and the length of the program desired to be recorded. For example, if a user enters 5:00 pm as the expected start time and 1 hour as the length, then the established stop time is 6:00 pm. This value is adjusted depending on when the system receives the VPS code for the next program after receiving the VPS code for the desired program.

Second, applicant argues the VPS system does not provide a message when the length of said entertainment program becomes ascertainable by said delivery source (applicant's remarks, page 10, third paragraph, regarding claim 72).

In response, it must be noted that the delivery source has clearly ascertained the length of the previous program once it has begun broadcasting the next program. Since the VPS codes are sent in conjunction with the beginning of programs, then the message which causes the recording device to

stop recording is sent at a point in time when the length of the desired program has been ascertained by the delivery source.

Third, applicant argues that the delivery source is different from the program, and that because the control codes are embedded within the program, they are not coming from the delivery source (applicant's remarks, page 10, third paragraph, regarding claim 72, and the last paragraph regarding claim 74).

In response, the programming itself originates from the delivery source, and thus codes which are embedded in the VBI of a program coming from a delivery source are obviously codes coming from the delivery source.

Fourth, applicant argues that the start time of the next program is distinct from the stop time of the previous program, and since the VPS only sends messages heralding the start time of programs, the VPS does not send stop time messages containing the stop time of a program (applicant's remarks, page 11 first paragraph regarding claim 75).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a stop time message containing the stop time of a program) are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The stop

time message, as recited, enables "said recorder to stop recording said entertainment program at said received stop time". There is no recitation in the claim to specify the stop time message contains any information, thus the time at when the stop time message is received is read to be the stop time itself.

Fifth, applicant argues that the received end time message can be delivered either during the program or at the end of the program, stating the VPS only delivers messages during the start time of a new program and thus cannot teach the amended limitations (applicant's remarks, page 11, third paragraph regarding claim 76).

In response, the examiner must note that the amended limitations are recited in the alternative, such that only one of the alternative claim limitations must be met by the prior art to teach the claimed invention. As such, the VPS teaches receiving an end time message at the end of a program, because the start of a new program occurs at the end of the previous program.

Sixth, applicant argues that the end control message is received concurrently with the end of the program, stating the VPS only delivers messages during the start time of a new program and thus cannot teach the amended limitation (applicant's remarks, page 12, first paragraph regarding claim 77).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the end control message is received concurrently with the end of the program) are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Lastly, applicant argues that the start time of the next program cannot in any manner be deemed to be as contemporaneous with the end time of the last program (applicant's remarks, page 12, fourth paragraph regarding claim s78 and 80).

In response, the examiner respectfully disagrees. The start time of a new program is a clear and definite point in time at which the previous program can be considered to have ended. Simply because there *may* be a station break or commercial messages between the closing credits of a first program and the introductory scenes of a new program does not invalidate the read that the end time of a first program is contemporaneous with the start time of the next program. If one looks at any typical program guide listing, it is immediately evident that the end time of a first program is considered to be the start time of the next program. For example if there are two 1 hour programs scheduled in

the 2:00pm – 4:00pm range, then 3:00pm is considered to be both the end time of the first program and the start time of the second program.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 47, 48, 57, and 72-80 are rejected under 35 U.S.C. 102(b) as being anticipated by Kwoh (5,852,478, of record).

Regarding claim 47, Kwoh discloses a method of adjusting recording time of an entertainment program (col. 2, lines 21-55), said method comprising:

selecting an entertainment program to be communicated to a user's premises, said program having scheduled start and stop times (col. 2, lines 21-25),

establishing a start and stop time in accordance with said scheduled start and stop times for recorded said selected program at said user's premises (a predicted start time and the start time plus the expected length of the program equate to a start and stop time in accordance with the schedule, col. 2, lines 21-25),

without action taken by said user, adjusting an established stop time of said established recording time to accommodate subsequent changes in program length (col. 2, lines 50-55).

Regarding claim 48, Kwoh discloses the method of claim 47, wherein said changes in program length occur after the start time of said program (col. 2, lines 47-55).

Regarding claim 57, Kwoh discloses the method of claim 47, further comprising transmitting for recording at said user's premises said selected program in accordance with said established start and stop times (col. 2, lines 47-50).

Regarding claim 72, Kwoh discloses a method for the delivery from a delivery source of entertainment programs for delayed viewing by recipients of said entertainment program, said entertainment program having an unknown length (col. 2, lines 21-55), said method comprising:

establishing a starting time for a particular entertainment program so as to allow for the setting of a recorder at said recipient's premises for recording a delivered one of said entertainment programs starting at said starting time (col. 2, lines 21-25 and lines 39-50), and

communicating from said delivery source to said recipient's recorder a message when the length of said entertainment program becomes ascertainable by said delivery source so as to enable said recipient's recorder to stop recording said entertainment program in accordance with said message (col. 2, lines 50-55).

Regarding claim 73, Kwoh discloses the method of claim 72, wherein said setting of said recorder is under the direct control of said recipient (col. 2, lines 21-25).

Regarding claim 74, Kwoh discloses the method of claim 72, further comprising:

receiving from said recipient listings of entertainment programs desired to be received by said recipient (col. 2, lines 21-25); and

wherein said setting of said recorder is under control of said delivery source based upon received ones of said desired entertainment program (col. 2, lines 34-53).

Regarding claims 75 and 76, Kwoh discloses a method and device for the recording of entertainment programs at a recipient's location, said entertainment programs received from a delivery source, said entertainment programs having an unknown length (col. 2, lines 21-55), said method comprising:

setting of a recorder at said recipient's premises for recording a delivered one of said entertainment programs starting at a time as determined by said delivery source (col. 2, lines 39-50), and

receiving by said recorder a message from said delivery source when the length of said entertainment program becomes ascertainable by said delivery source (message is received at the end of said entertainment program, which is the start of a new program) so as to enable said recorder to stop recording said entertainment program at said received stop time, and wherein said stop time corresponds to the ascertained stop time of said entertainment program (col. 2, lines 50-55).

Regarding claims 77 and 79, Kwoh discloses a method for recording TV programs at a user's premises, said TV programs delivered over a plurality of user selectable channels by a delivery source, said programs scheduled to begin at particular times (col. 2, lines 21-55), said method comprising:

setting in a recorder at said user's premises a particular channel and a particular start time corresponding to a program desired to be recorded by said user (col. 2, lines 21-25); and

receiving from said delivery source a message for use by said recorder to end said recording of said desired program (end time is adjusted for changes in length, col. 2, lines 50-55).

Regarding claims 78 and 80, Kwoh discloses the method of claims 77 and 79, wherein said message from said delivery source is contemporaneous with the end time of said desired program (col. 2, lines 50-52).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 81-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwoh in view of Durden et al. (5,003,384) [Durden].

Regarding claim 81-85, Kwoh discloses the methods and device of claims 47, 72, 75, 76, and 77, but fails to disclose stop time message is delivered to said recorder from said delivery source by a medium other than the entertainment program.

In an analogous art, Durden teaches a method for sending commands to control user premises equipment (col. 8 line 24 – col. 9 line 6), wherein the delivery medium for said commands is a stand alone dedicated data channel (col. 6, lines 34-42) for sending addressable commands to individual units, providing the benefit of a medium for sending control commands that allow users to access restricted or controlled services (see col. 11, lines 17-27, wherein deauthorization is a command sent from the service provider, col. 7 line 64 – col.

8 line 5, said commands useable to control the recording of a program on a VCR, col. 11, lines 57-65).

It would have been obvious at the time to a person of ordinary skill in the art to modify the methods and device disclosed by Kwoh to include delivering said stop time message to said recorder from said delivery source by a medium other than the entertainment program, as taught by Durden, for the benefit of sending commands over a medium which allows users to users to access restricted or controlled services for automatic recording.

Conclusion

6. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2623

7. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DS



JOHN MILLER
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